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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/643,570 | 08/19/2003 | Greg G. Griesse | 1149.1117101 | 4926 |

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04/29/2004

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EXAMINER

MRUK, BRIAN P

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/643,570 | Applicant(s) GRIESE, GREG G. | |
| | Examiner Brian P Mruk | Art Unit 1751 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11-14-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 8 is objected to because of the following informalities: In instant claim 8, the phrase "a anionic" should be amended to recite "an anionic" for grammatical purposes. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Goffinet, U.S. Patent No. 4,414,128.

Goffinet, U.S. Patent No. 4,414,128, discloses a liquid hard surface cleansing composition comprising water, 1-20% by weight of a surfactant, 0.5-10% by weight of a terpene, and 0.5-10% by weight of a polar solvent (see abstract and col. 2, lines 35-47). It is further taught by Goffinet that a preferred terpene includes d-limonene (see col. 2, lines 48-53), and that suitable nonionic surfactants include polyethylene oxide condensates of alkyl phenols (see col. 5, lines 14-28), condensation products of primary or secondary alcohols (see col. 5, lines 29-68), and condensation products of alkyl oxides and an amine (see col. 6, lines 1-8). Goffinet further discloses that the polar solvent includes glycol ethers (see col. 9, lines 1-34), and that the composition also contains hydrotropes, such as sodium xylene sulfonate (see col. 9, lines 35-45), and chelators, such as EDTA (see col. 7, line 50-col. 8, line 28). Specifically, note Examples 1-7 and 14-20. Therefore, instant claims 1-20 are anticipated by Goffinet, U.S. Patent No. 4,414,128.

4. Claims 1-20 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 10/391,639 (Griese et al) which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection

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under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application.

Copending Application No. 10/391,639 (Griese et al) exemplifies a composition comprising 53.4% by weight of water, 2% by weight of tall oil fatty acid, 2.8% by weight of monoisopropanolamine, 2.8% by weight of Na EDTA, 10% by weight of d-limonene, 10% by weight of Ethylan HB4, 2% by weight of SXS 40%, 12% by weight of Neodol 1-7, and 5% by weight of Neodol 1-3 (see page 27, Example 1), per the requirements of the instant claims.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-16 and 19-28 of copending Application No. 10/391,639. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/391,639 claims a similar composition comprising a terpene compound, a hydrophilic alcohol ethoxylate, an ethoxylated aryl alcohol and adjunct ingredients (see claims 1, 5-16 and 19-28 of copending Application No. 10/391,639), as required by applicant in instant claims 1-20. Although copending Application No. 10/391,639 discloses a similar composition, they are not identical, because copending Application No. 10/391,639 further requires a terpene compound (see claims 1 and 27 of copending Application No. 10/391,639) that is not required in the instant invention. Therefore, claims 1-20 of the instant invention are an obvious formulation in view of claims 1, 5-16 and 19-28 of copending Application No. 10/391,639.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Bm

Brian Mruk
April 27, 2004

Brian P. Mruk

Brian P. Mruk
Primary Examiner
Tech Center 1700